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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,555	02/27/2002	Shokyu Gen	F-7323	9841
28107	7590	04/07/2004	EXAMINER	
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			SCHNIZER, RICHARD A	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,555

Applicant(s)

GEN, SHOKYU

Examiner

Richard Schnizer, Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 1-4, and 7-9, 11, and 13, drawn to complexes comprising a formative agent, and a gene, and methods of using them to inhibit cell adhesion, classified in class 536, subclass 23.1.
2. Claims 1-3, 5-8, and 10-14, drawn to compositions comprising a formative agent and a cell adhesion inhibitor or immune tolerogen, and methods of using them to inhibit cell adhesion, classified in class 514, subclass 456.

Claims 1-3, 7, 8, 11, and 13 are generic to a plurality of disclosed patentably distinct inventions. These claims will be examined only to the extent that they are defined by the elected group.

The compositions and methods of group 1 are distinct from those of group 2 for the following reasons. The compositions and methods of group 1 comprise a gene complex which is structurally and functionally distinct from the cell adhesion inhibitor or immune tolerogen of group 2. The gene complex functions to introduce genes into cells, whereas neither the cell adhesion inhibitor nor immune tolerogen accomplish this purpose, or are intended to. While the gene complex could conceivably encode a cell adhesion inhibitor or an immune tolerogen, and could therefore be used in methods of inhibiting cell adhesion, such a method would function by a mechanism requiring entry of the complex into the cell and subsequent expression of the encoded gene product.

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The methods of group 2 do not account for this step, and so operate by a different mode and are functionally distinct.

### ***Election of Species***

Claims 1-14 are generic to a plurality of disclosed patentably distinct species comprising a stem cell, skin cell, mucosa cell, hepatocyte, islet cell, neural cell, cartilage cell, endothelial cell, epidermal cell, osteocyte and muscle cell isolated from human or animal organism, and sperm, ovum and fertilized egg of domestic animals or fishes. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Claims 1-14 are generic to a plurality of disclosed patentably distinct species comprising skin, blood vessel, cornea, kidney, heart, liver, umbilical cord, bowels, nerve, lung, placenta and pancreas. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and their

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recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Richard Schnizer, whose telephone number is 571-272-0762. The examiner can normally be reached Monday through Friday between the hours of 6:20 AM and 3:50 PM. The examiner is off on alternate Fridays, but is sometimes in the office anyway.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, John Leguyader, be reached at 571-272-0760. The official central fax number is 703-872-9306. Inquiries of a general nature or relating to the status of the application should be directed to the Patent Analyst Trina Turner whose telephone number is 571-272-0564.

DAVE T. NGUYEN  
PRIMARY EXAMINER



Richard Schnizer, Ph.D.